UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,346	09/29/2003	Dario De Judicibus	FR920030032US1	7141

30449 7590 03/05/2009

SCHMEISER, OLSEN & WATTS
22 CENTURY HILL DRIVE
SUITE 302
LATHAM, NY 12110

EXAMINER	
THEIN, MARIA TERESA T	
ART UNIT	PAPER NUMBER
3627	

MAIL DATE	DELIVERY MODE
03/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/676,346	JUDICIBUS ET AL.	
	Examiner	Art Unit	
	MARISSA THEIN	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) *9-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants' "Office Action Response" filed on December 23, 2008 has been considered.

Claims 7-8 are cancelled. New claims 9-12 are added. Claims 1-6 remain pending in this application. Claims 9-12 are withdrawn (see below).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over World Publication No. WO 96/13814 to Vazvan in view of U.S. Patent Application Publication No. 2003/0119478 to Nagy et al.

Regarding claims 1, 3 and, Vazvan discloses a method for booking and paying a retailer comprising: receiving at the transaction server (computing station located in the bank 24) the user wireless device an SMS (short message) containing a retailer identification (account number of payee) (page 5, lines 17-24); Reading at the transaction sever the number of the phone number of the phone number of the wireless device communicated by the carrier transporting the SMS (page 5, lines 1-4; computing station can identify the calling party (payer) because it has received the calling party's identify from the wireless network); authenticating the phone number and retailer

identification with the stored user information (page 15, lines 1-10) and sending the user confidential information to the retailer system (page 5, lines 24-25; the computing station transfers the amount of payment, mentioned on the bill from the payer's account to the payee's account); and the retailer entering payment information on the system and sending it with user information to transaction server (page 6, lines 16-26; customer.. gives...SIM card or credit card to the waiter to be entered into the waiter's portable telephone. Then waiter dials the telephone number of computing station or the number is dialed automatically after the SIM card or credit card has been read by the SIM card or credit card reader of the waiter's portable terminal.....In the bank, the computing station checks the account information of payer).

However, Vazvan does not explicitly disclose POS and the user entering on the POS the user code and POS reading and authentifying the user code; and executing the step if the user code is identified as belonging to the user confidential information. Vazvan does teach the waiter's portable telephone or terminal having a reader that reads the SIM card or credit card of the payer (page 6, liens 19-20).

Nagy, on the other hand, teaches POS and the user entering on the POS the user code and POS reading and authentifying the user code; and executing the step if the user code is identified as belonging to the user confidential information (paragraph 73; paragraph 75).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and computer program of Vazvan, to include POS and the user entering on the POS the user code and POS reading and

authentifying the user code and executing the step if the user code is identified as belonging to the user confidential information as taught by Nagy in order to provide authenticate the subscriber to the financial network (Nagy, paragraph 35).

Regarding claims 2, 5-6, Vazvan discloses executing step if the phone number is identified as belonging to user information on the transaction server (page 15, lines 1-10) encrypting the data and decrypting data (page 3, lines 33-38; user identify transmitted from the portable terminal to the network is completely encrypted and secured).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over World Publication No. WO 96/13814 to Vazvan and U.S. Patent Application Publication No. 2003/0119478 to Nagy et al. as applied to claim 1 above, and further in view of U.S. Patent Application Publication No. 2003/0187795 to Lee et al.

Regarding claim 4, Vazvan and Nagy substantially discloses the claimed invention, specifically disclosing transmitting user confidential information wherein the user code comprises a PIN; storing at the transaction server the user confidential number adding a user identification string (mPIN) ; and sending the user string (Nagy, paragraph 54).

However, the combination does not explicitly disclose entering the user identification string; authentifying the user string; if identified entering the user PIN; authentifying the user string with said user confidential information and executing the steps on if the user PIN is identified.

Lee, on the other hand, teaches entering the user identification string; authentifying the user string; if identified entering the user PIN; authentifying the user string with said user confidential information; and executing the steps on if the user PIN is identified (abstract and paragraph 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include entering the user identification string; authentifying the user string; if identified entering the user PIN; authentifying the user string with said user confidential information and executing the steps on if the user PIN is identified, as taught by Lee, in order to provide authenticate the user.

Election by Original Presentation

Newly submitted claims 9-12 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims have separate utility such as a first user telephone number and a second user telephone number; said transaction server verifying that the second user telephone number matches the first user telephone number; a fee required to be paid by the user to the retailer with respect to the transaction; a second user identification identifying the user and the retailer had confirmed that the second user identification matched the first user identification.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-12 are withdrawn from consideration

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments filed December 23, 2008 have been fully considered but they are not persuasive.

Applicants remark that "Vazvan in view of Nagy does not teach or suggest the feature: reading at the transaction server the phone number of the wireless device communicated by the carrier transporting the SMS".

Examiner does not agree. Vazvan teaches the disclosure above. Vazvan discloses a computing station which can identify the calling party because it has received the calling party's identify form the wireless network and compared with the calling party's identify based in the computing station (page 5, lines 1-5). Further, Vazvan teaches the computing station can identify the calling party. This needs that the user information should be confirmed by his/her telephone operator or service provider in a wireless communication network. User identity can be sent by user's telephone operator or service provider to the computing station when portable terminal set-ups a call or a short message to the computing station. Monitoring a calling party's subscriber number at a receiving terminal is a feature provided by today's digital telephone systems. (Page 3, lines 11-20)

Such computing station which can identify the calling party because it has received the calling party's identify form the wireless network and compared with the calling party's identify based in the computing station; user identity which can be sent by

user's telephone operator or service provider to the computing station when portable terminal set-ups a call or a short message to the computing station monitoring a calling party's subscriber number at a receiving terminal is a feature provided by today's digital telephone systems are considered "reading at the transaction server the phone number of the wireless device communicated by the carrier transporting the SMS".

Applicants remark that "Vazvan in view of Nagy does not teach or suggest the feature: authentifying said phone number and retailer identification with the stored confidential user information in combination with a transaction server storing confidential user information including a retailer identification, a user code and a user wireless device phone number".

Examiner does not agree. Vazvan teaches a mobile user who wants to pay a bill from an account to other, wherein he/she enters all information required for payment, such as his/her account number, the payee's account number, payment's due date, bill's reference number etc, to the mobile payment part of his/her portable terminal. Vazvan teaches the computing station can identify the calling party. This needs that the user information should be confirmed by his/her telephone operator or service provider in a wireless communication network and then sent to the bank as a confirmation of user subscriber identification. User identity can be sent by user's telephone operator or service provider to the computing station when portable terminal set-ups a call or a short message to the computing station. Monitoring a calling party's subscriber number at a receiving terminal is a feature provided by today's digital telephone systems. (Page 3, lines 7-20) Vazvan further teaches the communication network confirms and sends

the user identify to the computing station. The computing station checks the calling party's account and account number of payee (the account to which the payment should be transferee) and then transfers the required amount of payment from the payer's account to the account of the payee. (Page 4, lines 16-32) The Examiner then turns to Nagy to teach the user code.

Such computing station can identify the calling party; user information should be confirmed by his/her telephone operator or service provider in a wireless communication network and then sent to the bank as a confirmation of user subscriber identification; communication network which confirms and sends the user identify to the computing station; computing station checks the calling party's account and account number of payee (the account to which the payment should be transferred) and then transfers the required amount of payment from the payer's account to the account of the payee; and Nagy's user code are considered "authentifying said phone number and retailer identification with the stored confidential user information in combination with a transaction server storing confidential user information including a retailer identification, a user code and a user wireless device phone number".

Applicants remark that "Vazvan in view of Nagy does not teach or suggest the feature: sending the user confidential information to the retailer POS in combination with a transaction server storing confidential user information including a retailer identification, a user code and a user wireless device phone number".

Examiner does not agree. Vazvan teaches a mobile user who wants to pay a bill from an account to other, wherein he/she enters all information required for payment,

such as his/her account number, the payee's account number, payment's due date, bill's reference number etc, to the mobile payment part of his/her portable terminal. Vazvan teaches the computing station (retailer) can identify the calling party. This needs that the user information should be confirmed by his/her telephone operator or service provider in a wireless communication network and then sent to the bank as a confirmation of user subscriber identification. User identity can be sent by user's telephone operator or service provider to the computing station when portable terminal set-ups a call or a short message to the computing station. Monitoring a calling party's subscriber number at a receiving terminal is a feature provided by today's digital telephone systems. (Page 3, lines 7-20) Vazvan further teaches the communication network confirms and sends the user identify to the computing station. The computing station checks the calling party's account and account number of payee (the account to which the payment should be transferee) and then transfers the required amount of payment from the payer's account to the account of the payee. (Page 4, lines 16-32) The Examiner then turns to Nagy to teach the POS and user code.

Such computing station can identify the calling party; user information should be confirmed by his/her telephone operator or service provider in a wireless communication network; user identity can be sent by user's telephone operator or service provider to the computing station when portable terminal set-ups a call or a short message to the computing station; communication network confirms and sends the user identify to the computing station; computing station checks the calling party's account and account number of payee (the account to which the payment should be transferred) and then

transfers the required amount of payment from the payer's account to the account of the payee; and Nagy's POS system and user code are considered sending the user confidential information to the retailer POS in combination with a transaction server storing confidential user information including a retailer identification, a user code and a user wireless device phone number.

Applicants remark that "Vazvan in view of Nagy does not teach or suggest the feature: the user entering on the POS the user code and the POS reading and authentifying the user code with the user confidential information received from the transaction server."

Examiner does not agree. Nagy was cited for teaching "the user entering on the POS the user code and POS reading and authentifying the user code". Nagy teaches financial account PIN which the subscriber entered which is validated by the financial institution at the time of the transaction (paragraph 73). Nagy further teaches the subscriber interaction with the system can also occur using retail point of sale devices or terminal (paragraph 75) In addition, Vazvan discloses the mobile phone subscribers can pay bills using their subscriber identify or code (page 2, lines 18-21). The Examiner then turns to Vazvan to disclose "the user confidential information received from the transaction server." (See discussion above)

Such financial account PIN which the subscriber entered which is validated by the financial institution at the time of the transaction; the subscriber interaction with the system can also occur using retail point of sale devices or terminal; and Vazvan disclosing "the user confidential information received from the transaction server" are

considered "the user entering on the POS the user code and the POS reading and authentifying the user code with the user confidential information received from the transaction server."

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARISSA THEIN whose telephone number is (571)272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./
Examiner, Art Unit 3627
March 2, 2009

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627